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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL HARTMANN BAYM,  
RODERICK A. HYDE, JORDIN T. KARE,  
EREZ LIEBERMAN, ELIZABETH A. SWEENEY, and  
LOWELL L. WOOD, JR.

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Appeal 2015-004608<sup>1</sup>  
Application 13/068,301  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and  
MICHAEL W. KIM, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1, 3, 4, 11, 16, 22–25, 28, 33, 34, 37, 41–43, 45, 57, 61, 65, 69, 71–73, 79, 84, 86, 90–93, 96, 101, 102, 105, 109–111, 113, 125, 129, 133, and 137–170. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

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<sup>1</sup> The Appellants identify Searete LLC as the real party in interest. Appeal Br. 4.

The invention relates generally to evaluating biological samples.  
Spec. 2, ll. 3–11.

Claim 1 is illustrative:

1. A system, comprising:

an evaluation module for automatically evaluating a biological sample acquired from a subject to determine a first result of the evaluation, the first result of the evaluation including a presence or an absence of at least one pathogen in the biological sample, the evaluation module being located remotely from a health care facility and including at least one of a test strip, a lab-on-a-chip device, an assay, a lateral flow test strip, a colorimetric test strip, a lateral flow colorimetric test strip, a transdermal testing device, or a lancet;

a non-transitory electronic memory for queuing the first result of the evaluation for transmission to an off-site entity; and

a benefit module for receiving a notification of a benefit for the subject after queuing the first result of the evaluation for transmission.

Claims 1, 3, 4, 11, 16, 22–25, 28, 33, 34, 37, 41–43, 45, 57, 61, 65, 69, 71–73, 79, 84, 86, 90–93, 96, 101, 102, 105, 109–111, 113, 125, 129, 133, and 137–70 are rejected under 35 U.S.C. § 101 as reciting ineligible subject matter.

Claims 1, 3, 4, 11, 16, 22–25, 33, 34, 37, 41, 42, 69, 71–73, 79, 84, 86, 90–93, 101, 102, 105, 109, 110, 138–45, 151, 153–60, and 166–70, are rejected under 35 U.S.C. § 103(a) as unpatentable over McGlennen (US 2006/0278242 A1, pub. Dec. 14, 2006) and Jung (US 2008/0183396 A1, pub. July 31, 2008).

Claims 28, 43, 45, 57, 61, 65, 96, 111, 113, 125, 129, 133, 137, 146–48, 150, 152, 161–63, and 165 are rejected under 35 U.S.C. § 103(a) as

unpatentable over McGlennen, Jung, and Walker (US 2006/0218011 A1, pub. Sept. 28, 2006).

Claims 149 and 164 are rejected under 35 U.S.C. § 103(a) as unpatentable over McGlennen, Jung, Walker, and Fuerst (US 2006/0036619 A1, pub. Feb. 16, 2006).

We REVERSE and enter a NEW GROUND OF REJECTION.

### ANALYSIS

#### Patentable subject matter

We are persuaded by Appellants' arguments that the claims recite more than an abstract idea including limitations that transform the abstract idea into eligible subject matter. Reply Br. 9–10.

The Supreme Court reiterated the two-step framework, set forth previously in *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1300 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If so, the second step is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether the additional elements “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (citing *Mayo*, 132 S. Ct. at 1291, 1297). In other words, the second step is to “search for an ‘inventive concept’--i.e., an element or combination of elements that is ‘sufficient to ensure that the

patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Id.* (citing *Mayo*, 132 S. Ct. at 1294).

The Federal Circuit has further instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games America, Inc.*, 2016 WL 4896481 (Fed. Cir. September 13, 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Each of independent claims 1 and 69 recite an evaluation module “including at least one of a test strip, a lab-on-a-chip device, an assay, a lateral flow test strip, a colorimetric test strip, a lateral flow colorimetric test strip, a transdermal testing device, or a lancet.” The Specification describes by example that “the evaluation module 110 can detect, in the biological sample, the presence or absence of a pathogen.” Spec. 7, ll. 12–14. The Specification also describes by example that “the test strip changes color which is easily detected.” Spec. 8, ll. 23–24. Claims 1 and 69, thus, limit their scope to the use of specific medical test devices, encompassing in their scope a device that can detect color. As such, we find that the claims prevent preemption of all automatic evaluation of biological samples, because the claims are narrowly tailored to require specific technological methods.

The Federal Circuit noted in *McRO* that the abstract idea exception has been applied to prevent patenting of claims that abstractly cover results where “it matters not by what process or machinery the result is accomplished” (*McRO*, 2016 WL 4896481 at \*8 (quoting *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1854))). In the case before us, claims 1 and 69

recite limitations for queueing for transmission and receiving of data, which are functions of a general-purpose computer. But the claims also require the use of a machine that can, for example, detect color or other indicators output by the specific medical test technologies claimed. It is clear that the claims require a specific claimed medical test device that improves “the relevant technology” of evaluating biological samples using an automated evaluation module to evaluate information from the claimed, prior-art medical test devices, which is an improvement over requiring a human to interpret the color of a test strip, for example. (*Id.*). The claims, therefore, do not recite an abstract idea, because they improve an existing technological process of using test strips and similar medical test devices.

For these reasons, we reverse the rejection of claims 1, 3, 4, 11, 16, 22–25, 28, 33, 34, 37, 41–43, 45, 57, 61, 65, 69, 71–73, 79, 84, 86, 90–93, 96, 101, 102, 105, 109–11, 113, 125, 129, 133, and 137–70 under 35 U.S.C. § 101.

*Rejections under 35 U.S.C. § 103(a)*

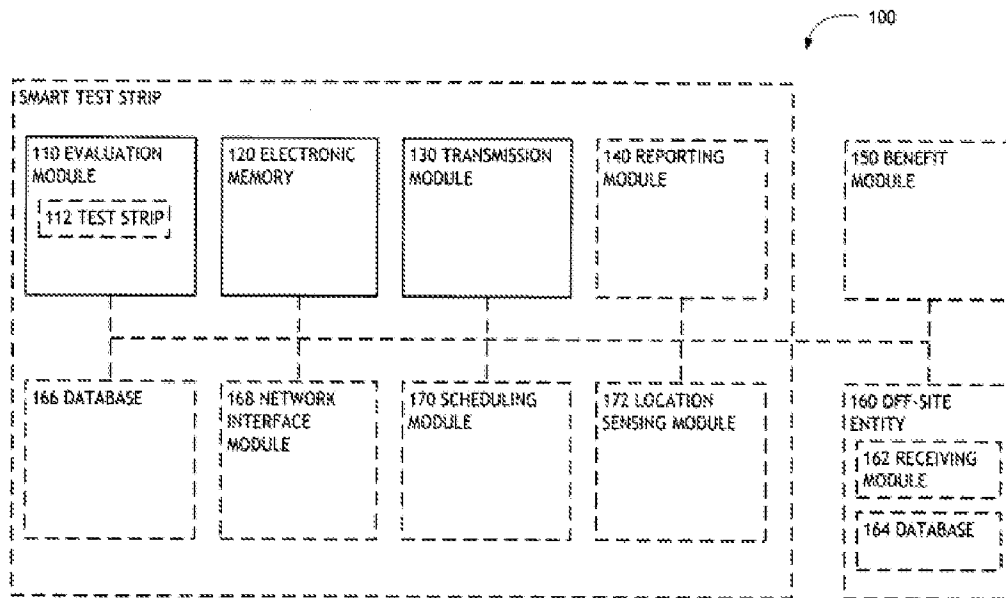
We begin by construing the meaning of independent claims 1 and 69, which each recite “an evaluation module for automatically evaluating a biological sample . . . the evaluation module being located remotely from a health care facility.” During prosecution the PTO gives claims their “broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, (Fed. Cir. 2000).

Appellants do not define or limit the meaning of “located remotely,” so we rely on the ordinary and customary meaning of “remote,” which is “far removed in space, time, or relation.” MERRIAM-WEBSTER ONLINE

DICTIONARY, <http://www.merriamwebster.com/dictionary/remote> (last viewed Jan. 24, 2017).

Appellants specifically define “health care facility” in that Appellants’ Specification states “[i]n the context of the present disclosure, a ‘health care facility’ includes any location where the evaluation of biological samples is performed.” Spec. 8, ll. 3–7.

Consistent with Appellants’ Specification, we construe the evaluation module to evaluate the biological sample, and, thus, is the location for the evaluation. In support of the language of claim 1, Appellants cite Figure 1 (Appeal Br. 5; *see also* Spec. 8, ll. 14–20), which shows an embodiment where a claimed test strip is within the evaluation module, as shown below:



Appellants’ Figure 1, showing test strip 112 within the evaluation module 110, which is thus the location of the evaluation of the biologic sample.

Claims 1 and 69, thus, recite, in light of Appellants’ definition and the ordinary and customary meaning of “remote,” automatically evaluating a biological sample, in a location far removed from any location where

biological samples are evaluated. The place where the biological sample is evaluated must, therefore, be at a place different from where the sample is evaluated, thus, making the claim impossible to meet. This is because the definition of “health care facility” that encompasses the location for evaluating samples, that must be separate from where the samples are evaluated, leads to a logically non-sensical result: the claimed evaluation module must be remote from itself.

The Examiner correctly pointed this out, stating “by definition a remote testing site using Appellant’s own recited system cannot exist.” Answer 7. Responding to Examiner’s observation, Appellants state “[a]ccording to the Examiner's interpretation, virtually any location on earth might be interpreted as a ‘health care facility.’” Reply Br. 12. We disagree with Appellants, because a proper construction of claims 1 and 69 means just the opposite: *no* health care facility/evaluation location meets the claim language, because the claim language is impossible to meet.

Where claims do not particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112, a § 103 rejection of the claims must be reversed as impermissibly involving speculative assumptions as to the meaning of the claims. *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962). If no reasonably definite meaning can be ascribed to certain terms in the claim, “the subject matter does not become obvious - the claim becomes indefinite.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Therefore, we reverse *pro forma* the rejections under 35 U.S.C. § 103(a) of claims 1, 3, 4, 11, 16, 22–25, 28, 33, 34, 37, 41–43, 45, 57, 61, 65, 69, 71–73, 79, 84, 86, 90–93, 96, 101, 102, 105, 109–11, 113, 125, 129,

133, and 137–70. Using our authority under 37 C.F.R. § 41.50(b), we reject independent claims 1 and 69 under 35 U.S.C. § 112, second paragraph, as being indefinite, based on our inability to determine the precise meaning of “an evaluation module for automatically evaluating a biological sample” remote from the claimed health care facility that encompasses any location where evaluating a biological sample is performed, in claims 1 and 69. We also reject dependent claims 3, 4, 11, 16, 22–25, 28, 33, 34, 37, 41–43, 45, 57, 61, 65, 71–73, 79, 84, 86, 90–93, 96, 101, 102, 105, 109–11, 113, 125, 129, 133, and 137–70, because they depend from the rejected independent claims, and therefore recite the same indefinite language.

#### DECISION

We reverse the rejection under 35 U.S.C. § 101.

We reverse the rejections under 35 U.S.C. § 103(a) *pro forma*.

We enter a new ground of rejection of claims 1, 3, 4, 11, 16, 22–25, 28, 33, 34, 37, 41–43, 45, 57, 61, 65, 69, 71–73, 79, 84, 86, 90–93, 96, 101, 102, 105, 109–11, 113, 125, 129, 133, and 137–70 under 35 U.S.C. § 112, second paragraph, as indefinite.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2008). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)